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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,963

04/27/2005

Kaoru Fukuda

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4372 7590 05/26/2009  
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EXAMINER

ENIN-OKUT, EDU E

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

05/26/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
IPMatters@arentfox.com  
Patent\_Mail@arentfox.com

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/532,963</p>	<p><b>Applicant(s)</b> FUKUDA ET AL.</p>	
	<p><b>Examiner</b> Edu E. Enin-Okut</p>	<p><b>Art Unit</b> 1795</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Dah-Wei D. Yuan/  
Supervisory Patent Examiner, Art Unit 1795

/Edu E. Enin-Okut/  
Examiner, Art Unit 1795

Continuation of 11. does NOT place the application in condition for allowance because:

1. As to applicant's argument that,

"The Applicants respectfully submit that the catalyst coated carbon black particles of Fukuda would not provide at least the claimed water absorption properties or the claimed feature of "a differential pressure of the anode diffusion layer measured by the differential pressure measuring method is in a range of 60 to 120 mmAq." (See applicant's remarks, pp. 4-5.); and,

... The Examiner cites paragraph 11 of the instant specification in alleged support of the proposition that any diffusion layer containing carbon particles having a water absorption amount at saturated water vapor pressure of 60 [degrees] C of not less than 150 cc/g would automatically exhibit the claimed water absorption ratio. However, as is disclosed in Comparative Examples 22 and 31 in the present invention, merely using the carbon particles having water absorption amount of not less than 150 cc/g will necessarily yield a water absorption ratio of the anode diffusion layer in the range of from 40 to 85%. In the present invention, the water absorption ratio is set in the range of from 40 to 85% by adding the required amount of such carbon particles. Therefore, the Examiner's use of the instant specification and the conclusions drawn from that use are in error." (See remarks, p. 5.)

It should be noted that claim 1 recites, "... a water holding layer thereon containing water holding material for 5 to 20 wt% of total weight of an electron conductive material and the water holding material, or carbon particles having water absorption amount at saturated water vapor pressure at 60 C of not less than 150 cc/g" (emphasis added). The rejected claim does not recite a "required amount" for carbon particles having water absorption amount at saturated water vapor pressure at 60 C of not less than 150 cc/g. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

2. As to applicant's argument that,

"The Examiner seems to implicitly admit that the alleged combination of Haridoss and Fukuda does not provide at least the claimed differential pressure measurement on page 4 of the Office Action. For this claimed feature the Examiner relies on Haridoss by alleging that "Haridoss also teaches the polymer electrolyte fuel cell has an anode differential pressure less than 1 psig (4:61-63)." In fact the above quote from Haridoss actually refers to the polymer electrolyte fuel cell disclosed in the specification of Haridoss, not the polymer electrolyte fuel cell as allegedly modified by the Examiner. That is, the Examiner modifies the device of Haridoss and then relies upon a measurement pertaining to the device prior to the modification. This is improper." (See remarks, pp. 5-6.)

It appears that applicant has overlooked the portion of the rejection preceding that cited by applicant, "As to a differential pressure of the anode diffusion layer measured by the differential pressure measuring method is in a range of 60 to 120 mmAq, this limitation has been considered, and construed as functional limitation that adds no additional structure to the diffusion layer claimed. See MPEP 2144." (see p. 4 of the Final Action); and thus, applicant has not addressed that portion of the rejection. Further, although Haridoss et al., in view of Fukuda et al. and Kaiser et al., does not expressly disclose the differential pressure of the anode diffusion layer as recited in claims 1, 4 and 5, it is the position of the examiner that such the property is inherent, given that both Haridoss et al., in view of Fukuda et al. and Kaiser et al., and the instant invention have similar structures and composition, as discussed in the Final Action issued on January 7, 2009. A reference which is silent about a claimed invention features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. *In re Robertson*, 49 USPQ 1949 (1999). See MPEP 2112.